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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,175	10/14/2004	Noriyoshi Satoh	37107	1995
116	7590	01/20/2006	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			BALAOING, ARIEL A	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,175

Applicant(s)

SATO ET AL.

Examiner

Ariel Balaoing

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/31/2005 have been fully considered but they are not persuasive.

Regarding claim 2, the applicant argues, "KIM does not specifically disclose where a battery is located in the device. In KIM, the battery is not shown. The grounds for the rejection fail to offer any explanation as to why one of ordinary skill in the art would have considered the proposed modification obvious, apart from the unsupported assertion that a second information recording medium storage disposed in adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing would have been an obvious matter of design choice." (see page 8 of the remarks); the examiner respectfully disagrees. While KIM does not specifically show the location of the battery attachment portion, it is well known in the art to place the battery attachment portion within the rear of the cellular device. Also, it is clear from NUOVO that the battery attachment portion is located along a longitudinal axis of the cellular device (see the rejections of claim 1 regarding the battery attachment portion and Figure 8). The rejection of claim 2 states obviousness from the combination of NUOVO and KIM as to the placement of the second information-recording medium. As the placement of the second information-recording medium is seen as a clear design choice, it would have been obvious to one having ordinary skill in the art at the time the invention was made to design a portable device to include a second information recoding medium storage portion disposed in adjacent to the battery attachment portion

Art Unit: 2683

along a longitudinal direction of the housing within the housing, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

2. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over NUOVO et al (US 2004/0077391) in view of KATO (US 2003/0013418 A1).

Regarding claim 1, NUOVO discloses a portable terminal comprising (abstract): a battery attachment portion to which a detachable battery is attached (85-Figure 8; paragraph 74); an information recording medium storage portion (80-Figure 8; paragraph 74) for detachable storing an information recording medium in which information is recorded toward a battery attachment portion side (paragraph 74), the information recording medium storage portion being disposed in adjacent to the battery attachment portion (Figure 8; paragraph 74); and a battery housing portion, for storing the battery, which is constituted by the battery attachment portion and the information recording medium storage portion (87-Figure 8; paragraph 74), covered by a cover member (paragraph 74), wherein one major surface of the information recording medium is exposed when the cover member is detached from the battery housing portion (Figure 8; paragraph 74). Although NUOVO discloses the use of battery 79 and

Art Unit: 2683

battery cover 21 (paragraph 74), NUOVO does not expressly disclose wherein the cover member comprises a battery and a battery cover. KATO discloses wherein the cover member comprises an integrated battery and battery cover (paragraph 33). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify NUOVO to include an integrated battery and battery cover, as taught by KATO, both inventions relate to cell phone design. This is beneficial in that it allows a faster method of battery interchange.

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. NUOVO further discloses wherein the information recording medium storage portion and an input/output [keypad/display] portion for inputting and outputting information are disposed in an overlapped manner at a side of the information recording medium opposite to a surface of the information recording medium being exposed (Figure 1; paragraph 41-47).

5. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over NUOVO et al (US 2004/0077391) in view of KATO (US 2003/0013418 A1), and further in view of KIM (US 6,681,120 B1).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. NUOVO further discloses wherein the battery housing portion is provided in a housing of a substantially rectangular parallelepiped (85-Figure 8). However, the combination of NUOVO and KATO does not disclose a second information recording medium storage, for storing in a detachable manner an information recording medium. KIM discloses a second information recording medium

Art Unit: 2683

storage, for storing in a detachable manner an information recording medium (abstract). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a connector that allows the means for accessing a secondary detachable memory, as taught by KIM, as both inventions relate to portable device construction. This is beneficial in that it allows the invention of the combination of NUOVO and KATO to include both a subscriber based memory module as well as a larger memory type for holding multimedia files. However, the combination of NUOVO, KATO and KIM does not disclose wherein the second information recoding medium storage portion is disposed in adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing. The combination of NUOVO, KATO and KIM discloses the claimed invention except for wherein the second information recoding medium storage portion is disposed in adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a portable device to include a second information recoding medium storage portion disposed in adjacent to the battery attachment portion along a longitudinal direction of the housing within the housing, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. NUOVO further discloses wherein the housing includes: a first housing (paragraph 15); a second housing (paragraph 15); and a hinge

Art Unit: 2683

portion for coupling the first housing and the second housing in a manner capable of being folded (paragraph 15; a clam shell design with a two or more part arrangement able to be rotated relative to each other is disclosed; a first housing, second housing and hinge is inherently necessary when a portable device is designed in such a way).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. NUOVO further discloses wherein the information recoding medium has a substantially rectangular parallelepiped shape (80-figure 8; 81-figure 13; paragraph 74), and wherein the information recording medium coincides with a direction orthogonal to the longitudinal direction of the housing (80-figure 8).

However, the combination of NUOVO and KATO does not disclose wherein the second information recoding medium has an almost rectangular parallelepiped shape, wherein the second information recording medium storage portion is disposed in a manner that a longitudinal direction of the second information recording medium coincides with the longitudinal direction of the housing. KIM discloses wherein the second information recoding medium has an almost rectangular parallelepiped shape (200-Figure 1), wherein the second information recording medium storage portion is disposed in a manner that a longitudinal direction of the second information recording medium coincides with the longitudinal direction of the housing (Figure 1; column 2:lines 10-45). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of the combination of NUOVO and KATO to include a second information medium and a second information storage portion, as taught by KIM, as both systems relate to the design of a mobile device. This

is beneficial in that it allows the combination of NUOVO and KATO to include both a subscriber based memory module as well as a larger memory type for holding multimedia files.

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However, NUOVO does not disclose wherein the housing has an opening portion for storing the second information recording medium within the second information recording medium storage portion, and wherein the opening portion is covered by an open/close lid in a manner that the lid moves in a direction orthogonal to a housing direction of the second information recording medium and rotates in a freely closing and opening manner with respect to the housing. KIM discloses wherein the housing has an opening portion for storing the second information recording medium within the second information recording medium storage portion (120A-Figure 1), and wherein the opening portion is covered by an open/close lid in a manner that the lid moves in a direction orthogonal to a housing direction of the second information recording medium and rotates in a freely closing and opening manner with respect to the housing (150, 152, 154-Figure 4). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include an opening in the case for a memory card with a protective covering, as taught by KIM, as both inventions relate to mobile terminal design. This is beneficial in that it allows a secure external method of memory card insertion.

Conclusion

Art Unit: 2683

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2683

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing
Art Unit 2683
Patent Examiner

AB



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